

Appl. No. 09/746,676

Attorney Docket: 042390.P10141

REMARKS

The above referenced patent application has been reviewed in light of the Office Action, dated June 16, 2005, in which:

- claims 1-37 are rejected under 35 U.S.C. § 112, 2nd paragraph as indefinite;
- and claims 1-6, 8, 10, and 17 are rejected under 35 U.S.C. § 102(e) on Whetsel (US Patent No. 6,408,413 B1).

Reconsideration of the above referenced patent application in view of the foregoing amendments and the following remarks is respectfully requested.

A Petition for Extension of Time in order to extend the period for response 1 month(s), including the appropriate fee, is filed herewith.

Claims 1-37 are now pending the above referenced patent application. No new matter has been entered. No claims have been amended, cancelled, or added.

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1. 35 U.S.C. § 112, 2nd paragraph

1.1. Claims 1-29: "Configuration"

The PTO has rejected claims 1-29 under 35 U.S.C. § 112, 2nd paragraph. This rejection is respectfully traversed.

Applicants begin with claim 1. Claim 1 recites:

- 1 1: (Previously Presented) An apparatus which comprises:
- 2 a multi-core processor and
- 3 at least one test control mechanism, including at least one test access port
- 4 controller (TAPC) and a plurality of distributed data and control registers;
- 5 said multi-core processor and said test control mechanism having a
- 6 configuration so as to allow testing of said multi-core processor.

The PTO has claimed that "claim 1, line 5, 'configuration' is vague and indefinite."

Applicants respectfully disagree.

Applicants respectfully note that the term "configuration" was not considered indefinite during the previous two Office Actions. However, Applicants also note that the PTO does have the right to bring a § 112 rejection against these claims at this stage.

1.1.1. Claim interpretation standard

MPEP § 2111 sets forth the standard for claim interpretation during examination.

During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification. ... The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

MPEP § 2111.01 further sets forth the standard of claim interpretation in both the case where a term is not defined in the specification and the case where the term is defined in the specification.

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When not defined by applicant in the specification, the words of a claim must be given their plain meaning. In other words, they must be read as they would be interpreted by those of ordinary skill in the art. *In re Sneed*, 710 F.2d 1544, 218 USPQ 385 (Fed. Cir. 1983)

MPEP § 2111.01, 8th edition, 3rd paragraph.

During examination, the claims must be interpreted as broadly as their terms reasonably allow. This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (discussed below).

MPEP § 2111.01, 8th edition, 1st paragraph.

MPEP § 2111 further sets forth that the Appellants may act as their own lexicographer, so long as the definition is not repugnant to the "plain meaning" of the defined term.

Applicant may be his or her own lexicographer as long as the meaning assigned to the term is not repugnant to the term's well known usage. *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947).

1.1.2. Claim interpretation as applied to Claim 1

Applicants respectfully assert that the Applicants use of the term "configuration" is within the plain meaning of the term and is therefore neither vague nor indefinite. Applicants start with the definition of "configuration":

configuration (ken-fig'ye-râ'shen) noun

1. a. Arrangement of parts or elements.
b. The form, as of a figure, determined by the arrangement of its parts or elements. *See synonyms at form.*

2. *Psychology.* Gestalt.

3. *Chemistry.* The structural arrangement of atoms in a compound or molecule.

- config'ura'tionally adverb

- config'ura'tive or config'ura'tional adjective

The American Heritage® Dictionary of the English Language, Third Edition © 1996 by Houghton Mifflin Company.

Applicants select the most common definition of the term "configuration", definition 1. Applicants respectfully assert that this definition is within the scope established by M.P.E.P. § 2111.01.

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Applicants argue that definitions 1a and 1b are essentially synonymous. If they were not essentially synonymous, the American Heritage Dictionary would have made them definitions 1 & 2 and opposed to combining them into a single definition. However, for the sake of argument Applicants will illustrate that neither definitions 1a nor 1b are vague or indefinite.

The definition of the verb "arrange", from which noun "arrangement" derives (which is used in definitions 1a & 1b of "configuration"), may be enlightening and is:

arrange (e-rānj') verb

arranged, arranging, arranges verb, transitive

1. To put into a specific order or relation; dispose: arrange shoes in a neat row.
2. To plan or prepare for: arrange a picnic.
3. To bring about an agreement concerning; settle: *"It has been arranged for him by his family to marry a girl of his own class" (Edmund Wilson).*
4. *Music.* To reset (a composition) for other instruments or voices or for another style of performance.

The American Heritage® Dictionary of the English Language, Third Edition © 1996 by Houghton Mifflin Company.

Once again, Applicants select the most common definition of the term "arrange", definition 1 "... a specific order or relation." Applicants respectfully assert that this definition is within the scope established by M.P.E.P. § 2111.01.

The definition of the noun "form" (which is used in definition 1b of "configuration") may be enlightening and is:

form (fōrm) noun

1. a. The shape and structure of an object. b. The body or outward appearance of a person or an animal considered separately from the face or head; figure.
2. a. The essence of something. b. The mode in which a thing exists, acts, or manifests itself; kind: a form of animal life; a form of blackmail.
3. a. Procedure as determined or governed by regulation or custom. b. A fixed order of words or procedures, as for use in a ceremony; a formula.

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4.A document with blanks for the insertion of details or information: insurance forms.

...

12. *Botany*. A subdivision of a variety usually differing in one trivial characteristic, such as flower color.

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Once again, Applicants select the most common definition of the term “form”, definition 1a “the shape and structure of an object.” Applicants respectfully assert that this definition is within the scope established by M.P.E.P. § 2111.01.

Therefore, Applicants respectfully assert that when Claim 1, lines 5 & 6 are read using the most common, plain meaning definition of the term “configuration” the lines would be understood to mean the following:

Original	said multi-core processor and said test control mechanism having a <u>configuration</u> so as to allow testing of said multi-core processor
Utilizing definition 1a	said multi-core processor and said test control mechanism (<u>i.e. the parts</u>) of having an <u>arrangement (i.e. put) in a specific order or relation</u> so as to allow testing of said multi-core processor.
Utilizing definition 1b	said multi-core processor and said test control mechanism (<u>i.e. the object</u>) having a <u>shape and structure</u> so as to allow testing of said multi-core processor.

Applicants assert that these three wordings of claim 1 are essentially synonymous and within the most common and plain meaning of the term “configuration.” Therefore, one could easily determine the meets and bounds of the claim without confusion. At worst, a casual reading of the specification and possibly a dictionary are all that is needed to fully understand the claim. Therefore, Applicants respectfully assert that the claim is neither vague nor indefinite and the rejection is improper. It is, therefore, respectfully requested that the rejection of this claim be withdrawn.

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Claims 2-29 either depend from claim 1, or include a substantially similar and patentably distinct language as claim 1. It is, therefore, respectfully requested that the rejection of these claims also be withdrawn.

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1.2. Claims 30-37: Claim 30, Lines 3 & 4

The PTO has rejected claim 30, and therefore claims 31-37, under 35 U.S.C. § 112, 2nd paragraph. This rejection is respectfully traversed.

Applicants begin with claim 30. Claim 30 recites:

1 30: (original) A method, comprising:
2 providing an indicator to identify a desired testing option;
3 based upon said desired testing option, dynamically routing signals between a
4 plurality test access ports (TAPs);
5 wherein said plurality test access ports (TAPs) are part of a multi-core
6 processor;
7 said multi-processor core including a plurality of processor cores.

Applicants respectfully note that these claims were not considered indefinite during the previous two Office Actions, and that the claims have not been amended. However, Applicants also note that the PTO does have the right to bring a § 112 rejection against these claims at this stage.

Applicants respectfully assert that claim 30 is neither indefinite nor fails to point out the claimed subject matter. While Figs. 3a, 3b, 3c, & 3d merely illustrate one non-limiting embodiment, they do illustrate an embodiment that helps explain the rejected claim.

As stated in the Office Action, the PTO is confused by the term “testing portion.” Applicants respectfully point out that the claim cites the term “testing option” and that “testing portion” appears to be a slight inadvertent misreading of the claim. Fig 3 shows an embodiment with four possible testing options; it is understood that this merely illustrates one non-limiting embodiment. In Fig. 3a the option to select testing of only core #1 is illustrated. In Fig 3b the option to select testing of only core #2 is illustrated. Figs. 3c & 3d illustrate the options that test

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the cores in series. As one would expect, which of these options is selected or desired is determined by a user.

The PTO asks "why dynamically routing signals between a plurality of test access ports (TAPs)?" Applicants respectfully note that a claim does not need to disclose the Applicants' motivations for making the invention; however, a few comments may further prosecution and understanding of the claim. As one possible reason, the signal may be dynamically routed in order to allow multiple testing options. If the signal's path was statically routed during manufacture, the user would have to select one testing option during manufacture. It may be important to remember that the term signal is not synonymous with the term physical wire. By dynamically routing the signal, a user may select a testing option on the fly. Once again Figs. 3a, 3b, 3c, & 3d illustrate an embodiment where the signals (TDI & TDO) are dynamically routed utilizing the Control Switch 139.

Applicants respectfully assert that claims 30-37 are neither indefinite nor fail to point out the claimed subject matter, especially when read in light of the specification and figures. It is respectfully requested that the foregoing claim rejections be withdrawn.

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2. 35 U.S.C. § 102

2.1. Whetsel: Claims 1-6, 8, 10, and 17

The PTO has rejected claims 1-6, 8, 10, and 17 under 35 U.S.C. § 102(e) as being anticipated by Whetsel. This rejection by the PTO of these claims is respectfully traversed.

It is well-established that in order to establish a *prima facie* case of anticipation under § 102 of the patent statute, the PTO must provide a single prior art document that alone has every element and every limitation of the claim being rejected. Therefore, if even a single element or limitation is not met by the asserted document, then the PTO has not succeeded in establishing a *prima facie* case.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicants begin with claim 1. Claim 1 recites:

1 1: (Previously Presented) An apparatus which comprises:
 2 a multi-core processor and
 3 at least one test control mechanism, including at least one test access port
 4 controller (TAPC) and a plurality of distributed data and control registers;
 5 said multi-core processor and said test control mechanism having a
 6 configuration so as to allow testing of said multi-core processor.

It is respectfully asserted that, as just one example of how the text cited by the PTO fails to meet the language of the rejected claims, Whetsel does not show, teach, use, or describe a plurality of distributed data and control registers. While Whetsel does show a plurality of TAPs, no TAP includes a plurality of distributed data and control registers. See, Whetsel Fig

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17. Also, see Whetsel, Fig. 1 in which two data registers (boundary-scan and bypass) is shown, and no control registers are illustrated. It is noted that one skilled in the art of TAP design will understand that both a boundary-scan chain and a bypass register are considered, and referred to in the IEEE 1149 specification as data registers. Applicants respectfully contend that Whetsel fails to satisfy a *prima facie* case of anticipation as directed by 35 U.S.C. § 102.

Claims 2-37 either depend from claim 1, or include a substantially similar and patentably distinct limitation as claim 1. It is, therefore, respectfully requested that the rejection of these claims also be withdrawn.

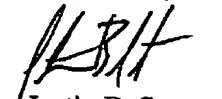
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CONCLUSION

In view of the foregoing, it is respectfully asserted that all claims pending in this application, as amended, are in condition for allowance. If the Examiner has any questions, they are invited to contact the undersigned at 503-264-7002. Reconsideration of this patent application and early allowance of all claims is respectfully requested.

Respectfully submitted,


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